

REMARKS

This paper is filed in response to the final office action mailed on April 23, 2004. Claims 1-3, 6-8, 10, 12-13 and 15 have been amended and claims 1-3 and 6-17 remain pending.

The final office action rejects claim 12 under 35 U.S.C. § 112, second paragraph as allegedly being indefinite. In response, claim 12 has been amended to traverse this rejection and other claims are also amended for clarification purposes.

Specifically, throughout the claims, the term "data" is used to define the part of the bit stream coded on the frames exclusive of the header and the term "value" is used to refer to the bits that are read, expressed, shifted, masked, etc.

With respect to the specific rejection directed toward claim 12, claim 12 requires a first masking circuit that receives at least two memory words but an output subset that excludes the rightmost bit and therefore the output of the first masking surface is a subset, having excluded the rightmost bit. Accordingly, applicants respectfully submit that claim 12 as amended is definite and in full compliance with 35 U.S.C. § 112, second paragraph.

With respect to the objections based upon the prior art, the office action rejects claims 12-14 under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,526,296 ("Nakahara"). Applicant respectfully submits that this rejection is improper for the following reasons.

Under MPEP § 2131,

[t]o anticipate a claim, the reference must teach every element of the claim. 'A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.'

Citing, Verdegaal Bros. v. Union Oil Co. of California, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987).

Applicant respectfully submits that Nakahara cannot serve as an anticipating reference because it does not teach or suggest every element of any pending independent claim. First, Nakahara does not teach or suggest a circular buffer for storing at bit stream that is coded in a plurality of frames. The term "circular buffer" or any equivalent is not found in Nakahara.

Second, Nakahara does not teach or suggest a circular buffer whereby the data stored in the circular buffer can be accessed at any location of a frame of the circular buffer. That is, any portion of any frame can be read and Nakahara does not teach or suggest this concept. Therefore, applicants respectfully submits that Nakahara cannot serve as an anticipating reference for claims 12-14.

Next, the office action rejects claims 15-17 under 35 U.S.C. § 103 as being unpatentable over Nakahara. Applicants respectfully submit that this rejection is improper and should be withdrawn for the following reasons.

At the outset, under MPEP § 2142,

[t]o establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. *Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations.* The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. (Emphasis Added).

Applicant respectfully submits that claims 15-17 are allowable over Nakahara for the same reasons that claims 12-14 are allowable over Nakahara. Specifically, Nakahara does not teach or suggest a *circular* buffer for storing a bit stream that is coated on a plurality of frames. Nakahara does not teach or suggest a circular buffer whereby the data can be accessed without any restriction as to the location of the data within a frame. Nakahara also does not teach or suggest storing a plurality of memory words without separately storing a header for the plurality of words. In short, Nakahara does not teach or suggest the advantages of the present invention as illustrated in Fig. 7 versus the prior art as illustrated in Fig. 1.

Accordingly, applicant respectfully submits that the rejection of claims 15-17 under 35 U.S.C. § 103 as being unpatentable over Nakahara is improper and should be withdrawn.

Finally, the office action rejects claims 1-11 under 35 U.S.C. § 103 as being unpatentable over Nakahara in view of U.S. Patent No. 6,065,107 ("Luick"). In response, applicant presents the following remarks.

Nakahara is deficient as a base reference for the reasons set forth above. Nakahara does not teach or suggest the circular buffer for storing a bit stream that is coated on a plurality of frames and the access of data stored in the circular buffer without any restriction as to the location of the data within a frame on the circular buffer. Because Luick does not teach or suggest the use of a circular buffer, and further because neither the term "circular buffer" nor any equivalent is found or suggested by Luick, Luick does not supplement Nakahara in this regard.

Specifically, in both Nakahara and Luick, data included in the frame which is previously accessed cannot be re-accessed. Thus, both Nakahara and Luick would need an additional buffer for storing data in the previously accessed frame when the size of the desired data is larger than that of each frame or when previously accessed data is needed to match data or a header in a presently accessed frame. Thus, neither Nakahara nor Luick teach or suggest the advantages of the present invention which are best understood upon comparing Figs. 1 and 7.

Therefore, the claimed apparatuses simply the structure of a bit stream processor and neither Nakahara nor Luick teach or suggest such a simplification. Accordingly, applicant respectfully submits that all claims are allowable over any hypothetical combination of Nakahara and Luick and an early action so indicating is respectfully requested.

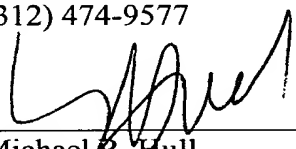
The Commissioner is authorized to charge any fee deficiency required by this paper, or credit any overpayment, to Deposit Account No. 13-2855.

Respectfully submitted,

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